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EXAMINER	
LIN, KENNY S	

ART UNIT	PAPER NUMBER
2152	

NOTIFICATION DATE	DELIVERY MODE
06/09/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/528,363	NG ET AL.	
	Examiner	Art Unit	
	KENNY S. LIN	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) *9-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 31-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/23/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-46 are presented for examination. Claims 9-30 are withdrawn.

2. The IDS submitted on 11/23/2007 is considered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2, 4, 6, 8, 34-36, 39-40, 43 and 46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter (e.g. software). The system claims comprises solely software/program elements and structures and/or software means for performing functions. As such, the claims are not limited to statutory subject matter and are therefore non-statutory. See MPEP § 2106.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 and 31-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification disclosed the claimed limitation of "forwarding the forwarded information (corresponding to the new mail events) to a remote device", "a means for forwarding server software that forwards the forwarded information to a remote device", "server software that conveys the information to a remote device", "forwarding the receipt data to a remote device". The specification did not disclose to forward information what was already forwarded elsewhere. Further, the specification did not disclose to forward information to a remote device. The specification did not disclose or suggest that a means for forwarding server software. Although one may assume that the remote device could be the same device as of the server, however, such assumption is not logical. If the server and the remote device is the same device, why would then there be a need to forward the forwarded information to the same device again? The specification disclosed nothing in regards to forwarding information to a remote device. Why is there a need to forward the forwarded information to a remote device? What the relevancy of the remote device is in associated with the server and client in the system?

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack proper antecedence basis:

i. Claim 2, line 12 – server software (server software already introduced in line 3);

ii. Claim 4, line 12 – server software;

iii. Claim 6, line 11 – server software;

iv. Claim 8, line 12 – server software.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-8 and 31-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US Patent 6,138,146.

11. Narasimhan and Moon were cited in the previous office action.

12. As per claims 1-2, Narasimhan taught the invention substantially as claimed including a method, comprising:

a. examining start criteria (col.1, lines 46-49, col.2, lines 3-6, col.5, lines 3-35; e.g. filter and forwarding parameters);

b. determining whether the start criteria have been met (col.5, lines 18-40); and

c. obtaining new email events from an email datastore after the start criteria have been met (col.4, lines 6-11, col.5, lines 37-40, 50-60, col.6, lines 3-6, 11-21, 40-56).

d. forward information corresponding to the new email events via a computer network to a datastore associated with the server (col.4, lines 6-11, 44-54, col.5, lines 3-17, col.6, lines 11-21, 40-56).

13. Narasimhan did not specifically teach the method is instructed by a computer program downloaded from a server computer system to a client personal computer and to forward the forwarded information to a remote device. However, it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

14. As per claims 3-4, Narasimhan taught the claimed invention including a method, comprising:

e. Establishing a communication channel between a server and with a client personal computer system (col.1, lines 40-43, col.2, lines 50-65, col.3, lines 39-44);

f. Obtaining new email events from an email datastore (col.6, lines 3-6);

g. Receiving information corresponding to the new email events from the client computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and

h. Storing the information corresponding to the new email events in a datastore associated with the server (col.4, lines 6-11, 44-54, col.6, lines 11-21, 40-56).

15. Narasimhan did not specifically teach the method is instructed by a computer program downloaded from a server computer system to a client personal computer and to forward the forwarded information to a remote device. However, it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

16. As per claims 5-6, Narasimhan taught the claimed invention including a method, comprising:

i. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);

j. Examining email data against the filter control data (col.5, lines 3-17);

k. Determine the email data that will be forwarded based on the examination (col.5, lines 3-40);

l. Selecting at least one transfer protocol for the email data based on the examination (col.5, lines 18-26, 37-49, col.6, lines 40-56, col.7, lines 39-45); and

m. Forwarding the email data according to the at least one transfer protocol via a computer network to a datastore associated with the server (col.4, lines 44-54, col.6, lines 19-21, 40-56).

17. Narasimhan did not specifically teach the method is instructed by a computer program downloaded from a server computer system to a client personal computer and to forward the forwarded information to a remote device. However, it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and implement the mail forwarding program to both the client computer and the servers to provide the functions of filtering and forwarding all incoming emails.

18. As per claims 7-8, Narasimhan taught the invention substantially as claimed including a method, comprising:

n. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);

o. Examining email data against the filter control data (col.5, lines 3-17); and

p. Determining based on the examination the email data that should not be forwarded (col.2, lines 3-6, col.5, lines 3-23);

q. Generating receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18);

r. Forwarding the receipt data via a computer network to a datastore associated with the server (col.4, lines 6-11, col.6, lines 11-21, 40-56); and

s. Forwarding the receipt data to a remote device (col.4, lines 6-11, col.6, lines 11-21, 40-56).

19. Narasimhan did not specifically teach the method is instructed by a computer program downloaded from a server computer system to a client personal computer; to forward the forwarded information to a remote device and to generate receipt data identifying the email data that should not be forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that should be forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded and it would have been obvious to download software and implement the server with an email forwarding application to forward the incoming email events to another device. Moon taught to forward the forwarded information to a remote device (col.2, lines 22-29) and to identify the email data that should not

be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block.

20. As per claims 31, 34, 37, 39, 41, 43 and 45-46, Moon further taught that the client personal computer is behind a firewall (figure 1: 18; col.3, lines 61-63, col.4, lines 45-46).

21. As per claims 32, 35, 42 and 44, Narasimhan and Moon did not specifically teach that the downloaded software self-installs. However, the concept and advantage of self-installing programs is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon and further self-install the downloaded programs to reduce user intervention and provide user-friendly installation process of software.

22. As per claims 33, 36, 38 and 40, Narasimhan further disclosed that the an email event includes an email (col.3, lines 7-9).

Conclusion

23. A shortened statutory period for reply to this Office action is set to expire **THREE MONTHS** from the mailing date of this action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kenny S Lin/
Primary Examiner, Art Unit 2152
June 5, 2008